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In The
United States Court of Appeals
For The Federal Circuit

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U.S. PATENT & TRADEMARK OFFICE

IN RE WILHELM ELSNER

**APPEAL FROM THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
BOARD OF PATENT APPEALS AND INTERFERENCES.**

BRIEF OF APPELLANT

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Date of Brief: October 20, 2003

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE ELSNER

No. 03-1569

Certificate of Interest

Counsel for the Appellant WILHELM ELSNER certifies the following (use "None" if applicable):

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Wilhelm Elsner

2. Than name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

Elsner Pac Jungpflanzen

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

4. There is no such corporation as listed in paragraph 3.

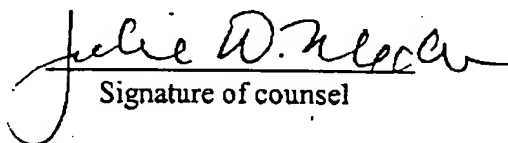
5. The names of all law firms and the partners or associates that appeared for the party of amicus now represented by me in the trial court or agency or are expected to appear in this court are:

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Kent E. Baldauf, Jr.

October 17, 2003

Date



Signature of counsel

Julie W. Meder

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STATEMENT OF RELATED CASES

The case of *In re Zary* before this Court in Docket No. 03-1585 is directed to the same issues on appeal. Appellant has been informed that the Office of the Solicitor is considering these two cases to be related.

JURISDICTIONAL STATEMENT

This Court has jurisdiction over this appeal pursuant to 28 U.S.C. § 1295(a)(4)(A) insofar as this is an appeal from a Decision on Appeal dated June 25, 2003 by the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. This Appeal was timely filed on July 9, 2003.

STATEMENT OF THE ISSUE

Is the subject matter of claim 1 of U.S. Application No. 09/664,247 filed September 18, 2000 entitled "Geranium Plant Named 'Pendec'" patentable over European Community Plant Breeders' Rights Application No. 97/0950 in view of a sale of a variety of geranium named 'Pendec' in Europe in 1998 under 35 U.S.C. § 102(b)?

STATEMENT OF THE CASE

The claim on appeal in the present application is directed to a variety of geranium named 'Pendec' which is described on five pages of specification and illustrated in an accompanying photograph. (A22-34) The application was filed on September 18, 2000 and a Preliminary Amendment was submitted on December 7, 2000. (A47-48)

The claim was rejected under 35 U.S.C. § 102(b) for lack of novelty over European Community Plant Breeders' Rights Application No. 97/0950 in view of a sale of a variety of geranium named 'Pendec' in Europe in 1998 in a first Office Action by the United States Patent and Trademark Office (USPTO) dated July 3, 2001. (A49-60). Appellant responded on October 3, 2001 with an Amendment (A63-84). The USPTO issued a second Office Action on November 9, 2001 (A85-95) to which Appellant replied with a Response on March 8, 2002

(A99-141). A final Office Action by the USPTO issued on April 23, 2002 (A142-153).

Appellant appealed the rejection in the final Office Action by submitting a Notice of Appeal to the Board of Patent Appeals and Interferences (Board) in Appeal No. 2003-0841 on July 16, 2002 (A155-156) and an Appeal Brief on August 26, 2002 (A158-179). The USPTO issued an Examiner's Answer on January 14, 2003 (A180-194). Appellant submitted a Reply Brief on February 24, 2003 (A195-214) with supplemental Appeal Brief on March 13, 2003 (A260-264). An oral hearing before the Board was held on March 26, 2003 in conjunction with the oral hearing for appeal of the application at issue in Docket No. 03-1585, *In re Zary*. A Decision on Appeal in case 2003-0841 issued on June 25, 2003. (Addendum) The Decision on Appeal included a statement that it was not written for publication and is not binding precedent of the Board.

STATEMENT OF THE FACTS

Appellant is a breeder of various botanical products, including geraniums, and resides in and conducts business in Germany. Appellant's products are propagated and sold in the United States through a licensing program. The claimed variety of geranium (botanically classified as *Pelargoniumx hortorum*) named 'Pendec' is the result of a mutation in a parent geranium plant named 'Pendred' that is the subject U.S. Application No. 09/663,856. The 'Pendec' plant

is propagated by asexual reproduction. Upon identification of the 'Pendec' plant as a new and distinct variety from its parent, Appellant began to propagate the plant and seek protection therefor.

An application for a Community Plant Variety Rights (CPVR) Certificate/Plant Breeders Rights (PBR) Certificate was filed with the Community Plant Variety Office (CPVO) in Europe for 'Pendec' on September 3, 1997 and received reference number EU 97/0950. On December 15, 1997, the Official Gazette of the CPVO published a listing of application EU 97/0950 (A82-83) with the following information:

Pelargonium L'Hérit. ex Alt.

a: 97/0950

a: 00089

pendec z-135

b: 03/09/97

b: 00449

(A82-83)

The name and address of the breeder and its representative, statement of botanical classification, and provisional denomination of the plant was available for public inspection. A variety of geranium named 'Pendec' was sold in Germany in July of 1998. The application of EU 97/0950 did not mature into a CPVR certificate and was subsequently withdrawn from application on May 10, 1999. (A84) No botanical data on the plant was available for public inspection.

The present application was filed in the USPTO for a variety of geranium named 'Pendec' on September 18, 2000. This variety was not commercialized in the United States prior to the U.S. patent application filing date.

SUMMARY OF THE ARGUMENT

The invention in this case is a variety of geranium plant named 'Pendec'. The plant is described and shown in the pending patent application as having a particular set of botanical characteristics including pink and white streaked flowers and dark green foliage. The plant originated as a mutation from another geranium plant (named 'Pendresd') that resulted in a new and distinct variety of geranium, the plant of the present invention. Plants of the 'Pendec' variety can only be propagated by asexual reproduction using biological material from an existing 'Pendec' plant. Access to the 'Pendec' plant and its progeny is the sole route for obtaining the plant. No realistic opportunity exists for genetically engineering another 'Pendec' plant based on any amount of description of the plant or even access to 'Pendresd', the plant from which 'Pendec' mutated.

The rejection of the patent claim to the 'Pendec' plant described and shown in the pending application is based on a printed publication and a sale of the variety outside the United States, both activities occurring more than one year before the filing date of the application. The cited publication contains minimal information on 'Pendec' and, as acknowledged by the USPTO, is not an enabling

publication that constitutes a bar to patentability under 35 U.S.C. § 102(b). Likewise, the sale of the 'Pendec' plant outside the United States is not a bar under 35 U.S.C. § 102(b) to patenting of 'Pendec'. Nevertheless, the claim to 'Pendec' is rejected over the non-enabling publication in view of the sale of the 'Pendec' plant. While neither the publication nor the foreign sale is a statutory bar to patenting of the 'Pendec' plant, the USPTO has refused to allow the pending claim asserting that the foreign sale of 'Pendec' enables the deficient publication to anticipate the claim.

The inability of a printed publication on a plant variety to anticipate a claim to that variety in a United States patent application was established by this Court's predecessor in *In re LeGrice*, 301 F.2d 929 (CCPA 1962). The *LeGrice* decision is replete with evidence of public use and sale of the claimed variety outside the United States. Nearly identical facts are present in this case, yet the USPTO now urges that extrinsic evidence of the public availability of the claimed plant may be used to enable the cited publication. If this Court upholds the Board's finding, it will be tantamount to reversing *LeGrice*.

In addition, extrinsic evidence may be used to explain the meaning of a cited publication only in very limited circumstances for determining anticipation under 35 U.S.C. § 102(b). *In re Baxter Travenol Labs.*, 952 F.2d 388 (Fed. Cir. 1991). It may not be used to supplement what is missing in a reference.

Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc., 726 F.2d 724, 727 (Fed. Cir. 1984).

The inability of the cited publication in this case to alone anticipate the claim cannot be corrected by looking to public availability of the 'Pendec' plant. To the extent that the existence of a 'Pendec' plant outside the United States explains what is set forth in the cited publication, such an explanation does not enable someone to possess the invention. At best, the cited publication may provide an information trail for a skilled person to locate a 'Pendec' plant outside the United States. The trail leading to information on the public availability of 'Pendec' is not a statutory bar.

This attempt by the USPTO to supplement what is missing in the cited publication thwarts the explicit law of 35 U.S.C. § 102(b) regarding sale of an invention outside the United States and is contrary to judicial precedent.

ARGUMENT

I. STATEMENT OF THE STANDARD OF REVIEW

This appeal challenges the refusal of the USPTO to allow the pending claim to a variety of geranium named 'Pendec' in U.S Application No. 09/664,247 for anticipation by a printed publication in view of a foreign sale under 35 U.S.C. § 102(b). The standard of review such a legal conclusion is "correctness or error

as a matter of law.” *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985). Questions of law are reviewed *de novo*. *Cooper v. Goldfarb*, 240 F.3d 1378 (Fed. Cir. 2001)

To the extent that a finding of anticipation by the Board is a question of fact, it is upheld if there is substantial evidence in the record to support the Board’s finding. *In re Hyatt*, 211 F.3d 1367, 1371-1372 (Fed. Cir. 2000). The “substantial evidence” standard asks whether a reasonable fact finder could have arrived at the Board’s decision. *In re Gartside*, 203 F.3d 1305 (Fed. Cir. 2000).

II. BACKGROUND ON PLANT PATENTS

The finding on appeal involves the interpretation of 35 U.S.C. § 102(b) as applied to patentability of a claim to a variety of geranium plant. Patent protection for asexually reproduced plants is governed by 35 U.S.C. §§ 161-164. The provisions of Title 35 apply to plant patents except as provided in those four sections. Hence, 35 U.S.C. § 102(b) applies equally to plants and utility inventions.

However, there are special aspects of plant inventions that provide a unique backdrop to this case. Only asexually reproduced plants can be the subject of a plant patent. 35 U.S.C. § 161. Asexual reproduction ensures that the progeny of a parent plant is identical in genetic makeup to the parent. Asexual reproduction is typically performed in geraniums by inducing a cutting from a plant (e.g., stem material) to develop roots. The rooted cutting grows into a full plant that is

identical to the plant from which the cutting was taken. Access to the desired variety of plant as a donor of plant material for creating a rooted cutting is required in order to propagate the plant. Without physical access to the specific variety of plant to be propagated, asexual reproduction of the plant cannot be performed.

Moreover, it is impossible today to produce a particular variety of plant based on any level of description thereof. Genetic engineering has not reached a point where a skilled artisan can take the information about a plant variety found in a printed publication and reproduce that same variety. A Declaration by an expert in horticulture, Dr. Richard Craig, submitted during prosecution of the appealed patent application (A137-140) succinctly sets forth the limitations of plant genetics. This inability to produce a particular plant variety based on its written description is recognized by the USPTO. See, Office Action dated April 23, 2002 (A142-153) and Decision on Appeal (Addendum).

III. TO UPHOLD THE BOARD'S FINDING WILL REQUIRE REVERSAL OF *LEGRICE*

In *LeGrice*, notwithstanding a clear finding of commercial activity (a published catalog) outside the United States, the court reversed a finding that publications on asexually produced plant varieties prohibited patenting in the United States.

The *LeGrice* court held that a printed publication anticipates a claimed invention when it discloses the invention "such that a skilled artisan could take its

teachings in *combination with his own knowledge of the particular art and be in possession of the invention*". *Id.* at 936, emphasis in original. In determining anticipation, the question arises of what it means to be "in possession of the invention".

The Board has characterized the accessibility of the claimed plant variety outside the United States as placing the public "in possession" of the invention. In so doing, the Board has attempted to circumvent the holding of *LeGrice* and impose a new standard of patentability that has no support in statutory or adjudicated law.

- A. In *LeGrice*, this court did not, nor could it, find that sales or other public activity outside the United States bars patenting in the United States.**

Section 102(b) of Title 35 provides the following bar to patenting based on activities occurring more than one year before the patent application filing date:

A person shall be entitled to a patent unless –

...
the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country...

Activities that are not statutory bars under 35 U.S.C. § 102(b) may be practiced without loss of patent rights in the United States. It follows that those

activities do not place the invention in the possession of the public, otherwise they would bar patenting from the outset.

Therefore, sale of the invention outside the United States or public use of the invention outside the United States cannot constitute "possession of the invention" or be used to evidence "possession of the invention".

The current attempt by the USPTO to cast the activities of sale or public use of the present invention outside the United States as constituting or evidencing "possession of the invention" is directly counter to statute and should be reversed.

B. In *LeGrice*, this court did not find potential access to an invention outside the United States was possession of the invention in the United States.

If this Court fails to reverse the Board's Decision, it will overturn *LeGrice*. The factual basis in *LeGrice* is substantially identical to the present case. The doctrine of *stare decisis* means that the outcome of the present case should likewise be no different from that of *LeGrice*. *Flowers v. United States*, 764 F.2d 759, 761 (11th Cir. 1985) ("*Stare decisis* means that like facts will receive like treatment in a court of law.") The Supreme Court explained the importance of that doctrine as being:

the means by which we ensure that the law will not merely change erratically, but will develop in a principled and intelligible fashion. That doctrine permits society to presume that bedrock principles are founded in the law rather than in the proclivities of individuals, and thereby contributes to the integrity of our constitutional system of government, both in appearance and in fact.
Vasquez v. Hillery, 474 U.S. 254, 265-266 (1986).

Since the *LeGrice* decision was rendered in 1962, the plant breeding community has operated under the rule set forth therein, namely, that a printed publication on a plant variety cannot anticipate a patent application on that variety, regardless of public access to the variety outside the United States. If the Board's decision in this case is upheld, the principles outlined in *LeGrice* can no longer be relied upon and dozens of published decisions relying thereon will become questionable.

At issue in *LeGrice* was whether a published catalog listing a variety of rose plant along with some botanical data and a color picture thereof barred patenting of that rose variety as a plant patent under 35 U.S.C. § 102(b). The record established identity at least in appearance between the rose plant illustrated in the catalog and the claimed variety.

The Appellant of *LeGrice*, (Mr. Edward Burton LeGrice) filed plant patent applications in the United States in 1958 on two rose varieties, Charming Maid and Dusky Maiden. Compelling evidence of public use or sale of the varieties in England was presented including listings of the varieties in the

National Rose Annual of England and catalogs, public exhibition of Dusky Maiden, and publication in The Rose Annual of 1954 that Charming Maid was distributed by Mr. LeGrice.

Despite all this evidence of sale and/or public use of Dusky Maiden and Charming Maid by Mr. LeGrice in England, the appeals court did not specifically address any issue of such activity undoubtedly because it occurred outside the United States.

In *LeGrice*, the court held a publication on a plant variety alone cannot anticipate a claim to that plant variety, and the court's holding is controlling here. The court focused on whether the publications (the Rose Annuals or the catalogs), when interpreted in light of the knowledge possessed by plant breeders, placed the rose varieties in the public domain. Importantly, when the court looked to what constituted the knowledge possessed by plant breeders, it did not consider the evidence of prior use and/or on sale of the rose varieties outside the United States. Although not termed as such, the "extrinsic evidence" considered by the court was the knowledge base of a skilled artisan. The "knowledge" for a skilled artisan was not—and still is not—the commercial activity of the breeder outside the United States.

In determining whether the catalog was an "enabling" disclosure, i.e., sufficient to give the public possession of the rose plant, the court pointed out the

following unique characteristics of plants as compared to manufactured articles. Plants protected by United States plant patents are asexually reproduced wherein the plant is propagated by divisions or cuttings to form clones, each of which is identical to its parent plant and to all other cuttings or clones taken from the parent plant. *Id.* at 937. Even when the parentage of the claimed variety is set forth in a publication, no two seeds produced by cross-pollinating the parent plants can be expected to produce identical plants. *Id.* at 938. The principles of heredity and plant genetics introduce innumerable possible combinations of genetic material which may result in equally innumerable distinct plants. *Id.*

The impossibility of producing a particular variety from a description thereof in a printed publication was a critical factor for the court in *LeGrice*. *Id.* at 936. The court emphasized that the description of the invention in the printed publication must be an “enabling” description and that the proper test of an enabling description in a publication as a bar to a patent under § 102(b) is “whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought.” *Id.* at 939.

To put an invention in possession of an invention based on a printed publication, the description therein must be:

so precise and particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill. *Id.* at 933.

In 1962, the *LeGrice* court recognized that the knowledge of plant genetics made it impossible to reproduce a particular plant having specific botanical characteristics based solely on a description of the plant, even when the parent plants were known. Despite the many advances in biotechnology over nearly 40 years, that limitation on reproducing plants holds true. See Declaration of Dr. Richard Craig. (A137-140)

The court was clearly focussed on whether a skilled artisan could “construct and operate” the invention based on his own knowledge of the art. Knowledge in *LeGrice* was never considered to include public use or sale or any other activity that could provide a trail of information leading to the physical location of the rose plants. Implicit in *LeGrice* is that the extrinsic evidence of public use or sale was irrelevant to determining enablement of the printed publications.¹

Nevertheless, proof of enablement of the PBR application in the present case has been attempted by bootstrapping overseas commercial activity

¹ The issue of public availability of the roses outside the United States was disposed of in the lower decision at the Board of Appeals. *Application of Edward Burton LeGrice*, Decision of Board of Appeals, February 12, 1960 (A205-210).

onto the PBR application. The Board found "possession" of the claimed invention by the following process:

- (1) read that a geranium plant named 'Pendec' was the subject of a PBR application in the CPVO;
- (2) learn the name of the plant breeder from the PBR application;
- (3) track down the location of that breeder in Germany; and
- (4) obtain a 'Pendec' plant from the breeder.

That process is merely a research trail of information leading to evidence of an activity that is not a statutory bar.

The potential for access to an invention is not a statutory bar to patenting the invention, yet that is the essence of the claim rejection in the present case. Dissemination of sales literature will not bar patenting when the literature is not enabling. For example, in *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339 (Fed. Cir. 1990), a challenge to the validity of a patented method of securing walls was based on distribution of a brochure partially describing the claimed method. The brochure was distributed at a trade show more than one year prior to the date of application for the patent. After finding lack of an enabling disclosure in the sales brochure, the court found no evidence that a skilled artisan could have practiced the method without undue experimentation. As in *LeGrice*, there clearly was significant evidence that one could have sought out the patentee to gain

information on the method. However, such a research trail was not even considered and the lower court's holding of summary judgment was reversed. *See also, Baldwin-Southwark Corp. v. Coe, Comm'r of Patents*, 55 USPQ 398 (Ct. Appeals, DC 1942) (no consideration by the court given to a potential for a trail to the claimed device that was described in a non-enabling trade circular.)

Sales literature provides a more direct route than a PBR application can provide to learn that a device or a plant is available for sale outside the United States. Yet in neither situation is it appropriate to look beyond the publication's teaching and evidence relating to a skilled artisan's knowledge to determine anticipation by the publication.

A PBR application which refers only to a species of a plant and a plant name cannot be considered to be so "precise and particular" that a skilled artisan could "construct and operate it without experiments and without further exercise of inventive skill." The ability to purchase a geranium named 'Pendec' one year prior to the application filing date is not equivalent to the ability to "construct and operate" a new geranium variety named 'Pendec' based on the PBR publication. One skilled in the art may have learned of a geranium named 'Pendec' - outside the United States. While public prior use and sale are some avenues by which a plant enters the public domain, that prior use or sale must have

occurred in the United States to rise to the level of a statutory bar. 35 U.S.C. § 102(b).

A PBR application could lead one skilled in the art to find a plant to purchase outside the United States which bears a name mentioned in the PBR application. That scenario is not one which renders the PBR application enabling. It is simply a trail that leads to a sale of a plant outside the United States. There is no support in *LeGrice* or elsewhere for the proposition that sale of a named plant outside the United States automatically enables the publication of a Plant Breeder's Rights application listing a plant with the same name.

IV. CONTRARY TO LAW, THE USPTO USED FOREIGN SALES ACTIVITY TO FILL THE GAPS IN THE NON-ENABLING PUBLICATION

Extrinsic evidence may only be used to explain the meaning of a printed publication for the purposes of determining claim novelty in a patent application.

A. Sales activity outside the United States is not prior art evidence showing "possession of the invention" in the United States:

Anticipation of a patent claim requires that all elements and limitations of the claim be found within a single prior art reference. *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). An

additional reference may only be used to show what the primary reference contains, and not to add what the primary reference lacks.

It is sometimes appropriate to consider extrinsic evidence to explain the disclosure of a reference. Such factual elaboration is necessarily of limited scope and probative value, for a finding of anticipation requires that all aspects of the claimed invention were already described in a single reference: a finding that is not supportable if it is necessary to prove facts beyond those disclosed in the reference in order to meet the claim limitations. The role of extrinsic evidence is to educate the decision-maker to what the reference meant to persons of ordinary skill in the field of the invention, not to fill gaps in the reference. *Id.* at 1576, emphasis added.

The extrinsic evidence used by the USPTO in the present case is knowledge of the sale of the claimed plant outside the United States. That information would only educate a skilled plant breeder that the plant listed therein was an established variety of geranium. The very significant gaps in the disclosure of the cited PBR (as acknowledged by the USPTO on the record) make it impossible to possess the invention simply by knowing that it was an established variety of geranium.

Alternatively, extrinsic evidence of the state of the art may be looked to for demonstrating the knowledge base of a skilled artisan. The “every element” rule for an anticipatory reference has some “modest flexibility” as stated in *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Extrinsic evidence may be relied upon when:

the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges.
Id. at 1269.

If the sale of 'Pendec' is used to show what is known by a skilled artisan, then that information is relevant to establishing what is not set forth in the PBR application, namely, that 'Pendec' was an established geranium variety.

The Board urges that the opportunity to "possess" a 'Pendec' plant by a trail of information is the same as the ability to "be in possession of the invention" as is required in an anticipatory reference. The Board has blurred the concept of possession of the invention based on the information in the PBR application with mere access to the plant outside the United States in stating "how can one be in any more 'possession' of the invention than to be able to hold the claimed invention in one's hands as here?" Decision on Appeal, p. 10 (A14). Certainly, one holding the plant in Germany would have been in possession of a plant named 'Pendec'. However, that activity is irrelevant to anticipation by a printed publication.

Proper extrinsic evidence in the present case would have been something akin to a reference that explained how a skilled plant breeder could take information on a plant and be able to produce that plant or to evidence of

established knowledge in the field of plant breeding on how to produce such a plant.

Extrinsic evidence has been looked to in patenting of chemical inventions. In each of *In re Samour*, 571 F.2d 559 (Fed. Cir. 1978) and also *In re Donohue*, 766 F.2d 531 (Fed. Cir. 1985), an additional reference was relied upon to demonstrate that the subject matter of an assertedly anticipatory could have been produced by a skilled artisan.

The claim at issue in *In re Samour* was directed to a specific chemical compound with the structure appearing in the claim. A first prior art reference disclosed the structural formula set forth in the claim but did not disclose a method for its preparation. An additional reference which disclosed a method for preparing similar types of compounds was cited to enable the primary reference. The court found that the mere recitation of the chemical formula of the claimed composition in a prior art reference would not have been sufficient to place the compound in the public's possession. Yet, the court was willing to consider relying on additional references:

solely as evidence that, more than one year prior to appellant's filing date, a method of preparing the claimed subject matter (DMMP) would have been known by, or would have been obvious to, one of ordinary skill in the art. Therefore, the key issue before us is whether the PTO, in making a rejection under 35 U.S.C. § 102(b) on a single prior art reference that discloses every material element of the claimed subject matter, can properly rely on additional references for such purpose.

Id. at 562, (emphasis added).

It framed the issue of whether the primary reference placed the claimed chemical compound "in possession of the public" as to "whether a method of preparing the claimed subject matter" would have been known by one of ordinary skill in the art. *Id.* The court held that "a method of preparing the claimed subject matter" was in the public domain when relying upon evidence in the secondary reference of appropriate preparation techniques.

The court maintained the rejection of the claim for the chemical compound based on the combined teachings of the printed publication disclosing the compound and a reference which disclosed a method for making similar compounds, explaining that the additional reference cited in the § 102(b) rejection was "not relied on for a suggestion or incentive to combine teachings to meet the claimed limitations" (as in a rejection under 35 U.S.C. § 103) but, rather, to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in the possession of the public. *Id.* at 563. The secondary reference was only used to demonstrate that the claimed subject matter, which was

fully disclosed in a printed publication, was within the ability of the skilled artisan to make, i.e. to possess.

A similar reasoning and result was found in *In re Donohue* where a claim also directed to a set of chemical compounds was rejected for anticipation by a primary reference that did not disclose methods of preparing the claimed compounds. Additional references relied upon by the United States Patent and Trademark Office taught how such compounds could be produced. The legal basis for upholding the rejection was outlined as follows:

It is well settled that prior art under 35 U.S.C. § 102(b)[sic] must sufficiently describe the claimed invention to have placed the public in possession of it. *In re Sasse*, 629 F.2d 675, 681, 207 USPQ 107, 111 (CCPA 1980); *In re Samour*, 571 F.2d at 562, 197 USPQ at 4; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 651-52, 223 USPQ 1168, 1173 (Fed. Cir. 1984). Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. See *In re LeGrice*, 301 F.2d at 939, 133 USPQ at 373-74. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), cert. denied, 382 U.S. 973, 86 S.Ct. 537, 15 L.Ed. 2d. 465 (1966). *Id.* at 533 (footnote omitted).

As such, the court again found possession of the invention in the ability to make the compound. See, *In re Sheppard*, 339 F.2d 238, 242 (CCPA 1942) where a claim to a chemical compound was held patentable over a reference

describing production of related compounds because the reference failed to teach how to make the specific compounds claimed in order for them to be in possession of the public.

Both *In re Samour* and *In re Donohue* involved claims to a class of chemical compounds that was fully disclosed in a prior art reference. The secondary references in both cases were not employed to show that the claimed chemical compounds could be produced based on available knowledge, i.e., that they were within the public domain.

In the present case, there is no extrinsic evidence that the claimed variety could be produced or made. In fact, there is no dispute here that there no teachings could be used to produce or make a 'Pendec' plant from the parent 'Pendresd' plant. Evidence that there was access to the 'Pendec' variety outside the United States is irrelevant.

B. In *LeGrice*, this court recognized that Congress legislated sales activity in a foreign country as not prohibiting the patenting of an invention in the United States.

The *Samour* and *Donohue* courts agreed that a secondary piece of prior art (a written publication) could be used to show the state of the art in the chemical field was in the public's possession, namely, that a chemical compound could be produced. However, disclosure of the botanical name (and possibly a few

other particulars) of a new and unanticipated asexually reproduced plant variety is not enough to anticipate a plant patent for the claimed variety.

In the present application, the USPTO relies on *Samour* and *Donohue* to support a position that the sale of a variety named 'Pendec' in Germany is some type of "reference" that indicates what knowledge was in the public domain. However, this line of cases permits use of a true reference, an additional piece of prior art (a pre-application filing date publication) or evidence of the knowledge in the public domain to demonstrate the knowledge of a skilled artisan. The sale of an invention outside the United States is not such a reference.

It is contrary to longstanding tenets of the patent laws to assert that sale of a claimed invention outside of the United States qualifies as a reference at all. The sale of a variety named 'Pendec' outside the United States is not prior art. It is not a reference that is appropriate to use as evidence of the public's knowledge. An assertion that the sale of a claimed invention outside the United States as a reference would vitiate the meaning of the on-sale bar of 35 U.S.C. § 102(b).

If the USPTO's position is maintained, it would be changing the landscape of the patent law. Appellant appreciates the USPTO's recognition that the PBR application by itself would not be an enabled publication. Yet in essence, contrary to the holding of *LeGrice*, the USPTO asserts that a non-enabling

published description of a claimed invention combined with the sale of that invention outside of the United States would be enough to satisfy an anticipation rejection under 35 U.S.C. § 102(b).

Such a position is untenable under United States law. By way of example, a simple (non-enabling) listing of a product (such as a computer) in a catalog or magazine published one year before an application for patent in the United States combined with the sale of that computer outside the United States more than one year before the application date would be enough to bar patent protection in our country. Such an assertion is ludicrous and the ramifications are endless if the Court changes precedent and decides that the PBR application combined with the sale of a geranium named 'Pendec' in Germany would be enough to bar patent protection in the United States.

V. PLANT BREEDERS NEED CONSISTENCY IN THE LAW ESTABLISHED BY *LEGRICE* BY A REVERSAL OF THE DECISION BELOW.

Time delays in breeding new plant varieties exist whether the breeding occurs in the United States or elsewhere. In the case of plants bred outside the United States, additional testing and trialing in the United States must take place to make sure the new plants are adaptable to the climatic conditions in this country. This often takes several years before the plants are deemed acceptable and actually enter the United States market. Only a few varieties tested

and trialed in the United States actually enter the United States market, and it is not economically feasible to file immediately on every variety to be tested. The new patent policy requires that such immediate filing take place thereby placing the foreign plant patent breeder at a distinct economic disadvantage.

A plant bred in Germany can be introduced much more quickly in Germany because it was bred and grown there from the outset. Therefore, there is often a sale in Europe more than one year before the United States plant patent application is filed. A sale outside the United States does not trigger a statutory patent bar and does not diminish the need to afford protection to foreign plant breeders seeking to introduce their horticultural developments into the United States.

This concept has been understood since at least the time that the Townsend-Purnell Plant Patent Act become law in 1930. The Plant Patent Act of 1930 was enacted "to afford agriculture, so far as practicable, the same opportunity to participate in the benefits of the patent system as has been given industry". H.R. 1129, 71st Congress, 2d Session (1930).

To-day the plant breeder has no adequate financial incentive to enter upon his work. A new variety once it has left the hands of the breeder may be reproduced in unlimited quantity by all. The originator's only hope of financial reimbursement is through high prices for the comparatively few reproductions that he may dispose of during the first two or three years. After that time, depending upon the speed with which the plant may be asexually reproduced, the breeder loses all control of his discovery. Under the bill the originator will have control of his discovery during a period of 17 years, the same term as under industrial patents. If the new variety is successful, the breeder or discoverer can expect an adequate financial reward. *Id*

Under the current examination practice, rejection of plant patent applications by foreign breeders who have not yet introduced their discoveries into the United States cuts off their opportunities of reaping adequate financial reward in the United States. Plant varieties which are not ready for introduction into the United States, but were sufficiently developed in Europe to be introduced there, are not given the benefit of the patent system as was intended by the Plant Patent Act of 1930. Without that benefit, foreign plant breeders "only hope of financial reimbursement is through high prices for the comparatively few reproductions that [they] may dispose of during the first two or three years" following introduction of varieties into the United States. *Id*. The Plant Patent Act of 1930 was adopted so that "plant patents will mean better agricultural products that will give the public more actual value for its dollar". Due to the current rejection policy and to the

detriment of the public, advances in agriculture made outside the United States may not reach this country.

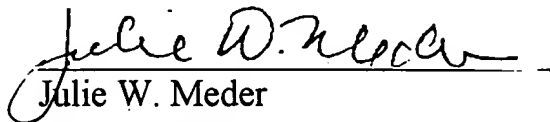
This policy by the USPTO represents a radical departure from any previous policy in the area of plant patent law. It has been estimated that under such a radical policy, 70% of the extant plant patents issued to foreign applicants in the United States are invalid.

Relying on use and sales outside the United States to turn a non-enabling plant disclosure into an enabling one was never contemplated by drafters of the Plant Patent Act, is not recognized by statute, is contrary to Patent Office policy from at least as early as the *LeGrice* decision (1962), and makes absolutely no sense to anyone skilled in the art. This new radical policy needs to be promptly reversed so foreign plant breeders have consistency in the United States law relating to plant in patent applications.

CONCLUSION

For the foregoing reasons, claim 1 of the present patent application is patentable under 35 U.S.C. § 102(b) and the Board's holding of anticipation must be reversed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Julie W. Meder", is written over a horizontal line.

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ADDENDUM

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¹ Addendum pages are numbered to match those within the Appendix.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WILHELM ELSNER

Appeal No. 2003-0841
Application No. 09/664,247

HEARD: March 26, 2003¹

MAILED

JUN 25 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WINTERS, WILLIAM F. SMITH, and ADAMS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision in an appeal under 35 U.S.C. § 134 from the examiner's final rejection of the claim pending in this plant patent application. We affirm.

BACKGROUND

The present invention relates to a geranium named Pendec. Pendec is a spontaneous mutation of "Pendred" and is asexually reproduced. Specification, page

¹ This appeal was heard in conjunction with Appeal No. 2003-0703, plant patent Application No. 09/267,559 and Appeal No. 2003-0704, plant patent Application No. 09/286,130. See Petition Under 37 CFR § 1.182, filed February 3, 2003, (Paper No. 15) and Request for Special Handling (Part of Paper No. 17). The three appeals have been decided concurrently.

1. There came a time when the owner of Pendec sought legal protection for Pendec in countries other than the United States. For example, appellant filed an application for a Community Plant Variety Rights (CPVR) Certificate/Plant Breeder's Rights (PBR) with the Community Plant Variety Office (CPVO) in Europe for Pendec on September 3, 1997 that was assigned reference number 97/0950. Application EU 97/0950 published on December 15, 1997 in the CPVO Official Gazette. Appellant admits that Pendec was sold in Germany in July of 1998. Reply Brief, page 1.

This plant patent application was filed on September 18, 2000, more than one year after the publication date, December 15, 1997, of EU 97/0950. The examiner has rejected the claim of this plant patent application under 35 U.S.C. § 102(b), concluding that EU 97/0950 is a printed publication within the meaning of this section of the statute. The examiner understood that the bare description of a claimed invention appearing in a printed publication published more than one year prior to the effective filing date of a patent claim is not a bar to the patenting of that claim if the printed publication is non-enabled, i.e., the disclosure of the publication "must be such that a skilled artisan can take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962). Examiner's Answer, Paper No. 13, page 3. The examiner concluded that EU 97/0950 is enabled or places the skilled artisan in possession of the invention since appellant has conceded that the claimed plant, Pendec, has been on sale or commercially available in countries other than the United States beginning in July of 1998.

Appellant's position is summarized at page 4 of the Appeal Brief (Paper No. 12) as follows:

The anticipation rejection in the present application has been characterized as based on the cited PBR application. According to the Examiner, the cited PBR application teaches every material element of the claim, despite its severe lack (or absence) of botanical information. The sale of a plant named Pendec outside the United States is used to show that the claimed subject matter was in the public domain more than one year prior to the application filing date.

The rejection is flawed in its reliance on a PBR application which does not disclose every material element of the claim and its attempt to circumvent 35 U.S.C. § 102(b) to reject a claim on an invention that may have been sold outside the United States.

Appeal Brief, (Paper No. 12), page 4.

DISCUSSION²

In relevant part, 35 U.S.C. § 102(b) reads:³

A person shall be entitled to a patent unless -- ... (b) the invention was ... described in a printed publication ... more than one year prior to the date of the application for patent in the United States,

However, not every "description" of something in a printed publication will necessarily bar the grant of a patent containing claims to that something. As stated in In re LeGrice, 301 F.2d at 931; 133 USPQ at 367, "[t]he underlying concept on which the

² The briefing in this appeal includes the Appeal Brief (Paper No. 12), a first Examiner's Answer (Paper No. 13) and the Reply Brief (Paper No. 14). At that point in time, the examiner re-opened prosecution and issued a new final rejection (Paper No. 16). Appellant requested that the appeal be reinstated and filed a Supplemental Appeal Brief (Paper No. 17). A second Examiner's Answer was entered (Paper No. 18). Appellant declined to file a second Reply Brief. See Paper No. 19.

³ This provision of § 102(b) is separate from the "on sale" and "public use" clause of this section of the statute. While the examiner refers to public availability of Pendec in countries other than the United States in terms of "on sale," we will use terms such as "publicly available" to describe this aspect of the evidence relied upon by the examiner to make clear that the rejection is not based on the "on sale" or "public use" provisions of § 102(b).

courts permitted such a bar is that the description of the invention in the printed publication was sufficient to give possession of the invention to the public."

Thus, the issue to be resolved is whether the "description" of the claimed geranium Pendec in EU 97/0950 is sufficient to "give possession of the invention to the public." Appellant and the examiner agree that no amount of written description of the claimed geranium Pendec would allow one to recreate the plant. This is seen in that Pendec is biological material created by a spontaneous mutation. Given the vagaries of nature and genetics, all agree that it is improbable if not impossible to recreate Pendec from the parent plant.

Here, however, the examiner does not rely upon the written words of EU 97/0950 as evidence that the printed publication placed Pendec in the possession of the public. In addition, the examiner relies upon the fact that the claimed geranium Pendec was also available to the public more than one year prior of the filing date of this plant patent application. In determining whether the description of Pendec in EU 97/0950 gave possession of the claimed plant to the public, the examiner concluded that being able to physically possess Pendec due to its public availability met the LeGrice test.

We agree with the examiner that EU 97/0950 is a statutory bar since it gave possession of Pendec to the public more than one year prior to the filing date of this plant patent application by way of (1) public announcement of the existence of Pendec by its publication and (2) the admitted public availability of the claimed plant. Simply put, it is difficult to imagine how much more the public can be put in "possession" of a claimed plant than be told of its existence by way of a printed publication and then be able to physically possess the plant by holding it in one's own hand since it is publicly available. Our reading of LeGrice and the other cases appellant relies upon does not lead us to appellant's conclusion, i.e., a description in a printed publication can only put

a claimed invention in possession of the public if the public can recreate the claimed invention from scratch. Rather, physical possession of the claimed plant is sufficient.

Appellant questions the examiner's use of multiple events to establish a statutory bar under the § 102(b), i.e., a printed publication describing a "thing" and public availability of the "thing" described in the publication. Specifically, appellant argues:

There is some flexibility in the rule that only one reference may be used in an anticipation rejection. An additional reference may be used to prove that the primary reference discloses subject matter which is in the public's possession. MPEP § 2131.01. Pursuant to this exception, a secondary reference may be included in an anticipation rejection only when the primary reference in and of itself is an enabling disclosure. An additional reference may be used to show what the primary reference contains-- and not to supplement what the primary reference lacks. In both of In re Samour, [571 F.2d 559, 197 USPQ (CCPA 1978)] and In re Donohue, [766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985)] (each relating to patent applications on chemical inventions), an additional reference was relied upon to show that the subject matter of a primary reference was available to the public. Neither case stands for the proposition that an additional reference may be used to supplement a non-enabling disclosure of a primary reference.

Appeal Brief, (Paper No. 12), page 5.

Appellant's argument appears to be circular. Appellant first states that it is proper to rely upon an additional reference in making an anticipation rejection to establish that the subject matter described by the so-called primary reference is in the possession of the public. This is what the examiner has done in this case. However, appellant goes on to argue that a so-called secondary reference may be included in an anticipation rejection "only when the primary reference in and of itself is an enabling disclosure." This latter statement is not understood since by definition the secondary reference is needed because the primary reference is not considered to be an enabling reference. If the primary reference was an enabled reference, one would not have to resort to so-called secondary references to establish that the "thing" described by the primary reference is enabled.

In our view Samour and Donohue are relevant in considering the present issue in that they provide legal support for the proposition that additional evidence may be relied upon to establish that a so-called primary reference is in fact enabled. However, we do not read Samour or Donohue as holding that the additional evidence to be used in establishing that the primary reference is enabled is limited to printed publications as opposed to actual objects that are publicly available.

Appellant argues that an anticipatory reference must describe "every material element of the claim." See, e.g., Appeal Brief, page 6. We agree. Appellant characterizes the primary reference in Samour as teaching every material element of the claimed compound by depicting the structural formula of the claimed compound. Appeal Brief, page 6. Appellant apparently views description of a chemical compound by its structural formula in a printed publication to be different from the description of a plant by name in a printed publication. We do not. A chemical compound is a physical substance just as a plant. In order to identify a chemical compound, workers in the field use words, e.g., ethanol, or structural formulas, e.g., $\text{CH}_3\text{CH}_2\text{OH}$. EU 97/0950 describes a plant using words, the name Pendec, as well as a brief taxonomic description, similar to a structural formula. A printed publication which simply describes "ethanol" or " $\text{CH}_3\text{CH}_2\text{OH}$ " does not necessarily describe how to obtain the compound which meets that description, just as a printed publication which describes the geranium Pendec, either by name or the most detailed taxonomic description, may not describe how to obtain that plant. Rather, workers in the respective fields must rely upon publicly available knowledge and their ordinary skill in order to obtain the chemical or the plant. Chemical compounds can be synthesized. That endeavor may be simple or complex. In Donohue and Samour, the USPTO provided sufficient evidence to conclude that a

worker in the relevant field would be able to obtain the compounds in dispute by way of synthesis using publicly available knowledge and routine skill.

While it is agreed that it is improbable if not impossible to recreate Pendec from the parent plant, the public is put in possession of Pendec just as assuredly as the chemical compounds in Donohue and Samour, if not more so by its public availability. This is seen in that the evidence relied upon by the USPTO in Donohue and Samour only provided instructions to one of ordinary skill in the art as to how to obtain the claimed compounds. One need not be concerned about "making" Pendec since appellant admits that it was publicly available in the relevant time frame. Again, physical possession of a claimed "thing" resolves any question that one can actually recreate the "thing" by way of instructions and knowledge contained in printed publications such as those relied upon in Donohue and Samour.

We note that the evidence relied upon by the examiners in Samour and Donohue established a constructive "possession" of the claimed compounds, not an actual "possession." If enablement of a reference can be established by evidence establishing that one could constructively be placed in possession of the claimed subject matter, it stands to reason that actual possession should also provide enablement. One should not have to reinvent the wheel if the wheel is publicly available.

Appellant argues that a plant cannot be reproduced from a description of the plant in a printed publication, relying upon the declaration filed under 37 CFR § 1.132 by Dr. Richard Craig. Appeal Brief, pages 9-11. That is not in issue as we agree that it is improbable if not impossible to recreate a plant from a written description of the plant.

Appellant also argues:

The LeGrice opinion does not directly address enablement of the printed publications on the claimed rose plant based on any other source, such as public availability of the plant.

However, implicit in LeGrice is that a publication describing a plant and a source to obtain that plant is not prior art to a plant patent application on that plant. The publications at issue in LeGrice included a national British publication on roses which disclosed the source of the rose plant at issue including the breeder's name and location and a catalog showing the rose plant. Although not specifically stated in LeGrice, the catalog indicated commercial availability of the rose plant. One skilled in the art, a plant breeder, could have determined the name and source of the rose plant and tracked down the rose plant. Despite availability of the rose plant (evidenced by the catalog), the court held the two publications to be incapable of placing the rose plant in the public domain. As should be true in this present application, the public use or sale of the rose plant outside the United States (such as via the catalog) were not of concern to the court in its analysis of statutory bars under 35 U.S.C. § 102(b).

Appeal Brief, page 11, (footnote omitted). This argument misapprehends the nature of appellate review. The record forwarded to an appellate tribunal contains numerous facts. However, not all facts contained in the record are relevant in deciding the issue framed and presented by the parties below. The question put squarely to the Board and the CCPA in LeGrice was whether a printed publication under § 102(b) must be enabling in the first instance, not how a printed publication can be considered enabled. The Board decided that a § 102(b) printed publication need not be enabled in the first instance. The CCPA reversed that decision, holding that a § 102(b) printed publication must be enabling. The question of how or in what manner a § 102(b) printed publication can be enabling was not presented to or decided by either tribunal. The examiner and Board could have presented a two tiered issue for review. First, whether a § 102(b) publication needs to be enabling in the first instance and second, if the first issue is answered in the affirmative, does the public availability of the plants provide the needed enablement. However neither the examiner nor the Board did so. Only the first issue was decided by the Board and CCPA.

We also note the examiner and appellant have discussed the relevance that a previous board decision, Ex parte Thomson, 24 USPQ2d 1618 (Bd. Pat. App. & Int. 1992) has on the facts of this case. Thomson was decided by a three member merits panel of the Board. At best the decision in Thomson constitutes the law of that case and would govern any further proceedings within the agency in regard to that patent application or its progeny. It is not controlling in this case. What is controlling in this case are the patent statutes and relevant precedent from the Federal Circuit and the CCPA. Thus we will not engage in a discussion of the facts or holdings of Thomson.

Appellant argues on page 15-17 of the Appeal Brief that:

An asexually reproduced plant is expected to have the same botanical characteristics as its parent plant. However, a mutation (spontaneous or otherwise) can cause an asexually reproduced plant to exhibit characteristics different from its parent plant. The characteristics of the plant described in EU 97/0980 are not identical to the characteristics specified in the claimed plant. EU 97/0950 simply does not contain sufficient information to indicate what particular variety is described therein, despite having the name 'Pendec'. As noted above, many pale pink geraniums could fit the description in EU 97/0950. Hence, the present application is more than just a better description of a plant described in EU 97/0950-- it is the definitive description of the variety named 'Pendec' claimed in the present application. The attempt to cast the botanical characteristics of the present invention as inherent properties of a vaguely described plant named 'Pendec' is an improper interpretation of and reliance on Donohue relating to the inherent properties of chemical compounds.

Appeal Brief, paragraph bridging pages 16-17.

We agree with appellant that the present application provides a better written description of Pendec than does EU 97/0950. However, that is beside the point in that neither written description enables one to recreate Pendec. What is significant is that appellant has not established the claimed Pendec differs from the Pendec described in EU 97/0950 and the Pendec which was publicly available in Germany more than one year prior to the filing date of this plant patent application.

In considering appellant's position in this appeal, we find it significant that the CCPA cast the test for an enabled printed publication under § 102(b) in terms of "possession of the invention" instead of using the "make and use" language found in the enablement requirement of 35 U.S.C. § 112, first paragraph. The ordinary and customary meaning of the word "possession" is "a possessing or being possessed; ownership, occupancy, hold, etc."⁴ One can possess something such as a plant without knowing how to make it or for that matter how it was made. Again, how can one be any more in "possession" of a claimed invention than to be able to hold the claimed invention in one's hands as here? The undisputed facts in this case establish that the public and consequently those of skill in this art were put on notice of the existence of Pendec by way of the printed publication relied upon by the examiner and the public and those skilled in the art were put in possession of the claimed plant by the public availability of Pendec.

Our agreement with the examiner's position that the "possession" test of LeGrice is satisfied by physical possession of the claimed invention as opposed to having constructive possession by knowing how to "make" the claimed invention is consistent with the manner in which enablement questions have been treated in utility applications claiming inventions involving biological material. In In re Argoudelis, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970), the claims under review were directed to new antibiotic compounds produced by a microorganism. It was conceded that the claimed antibiotic compounds could only be made if one had access to the microorganism starting material. Argoudelis at 1392, 168 USPQ at 100-101. However, as observed by the CCPA, one "cannot sufficiently disclose by written word how to obtain the

⁴ Webster's New World Dictionary of the American Language, Second College Edition, p. 1112 (The World Publishing Company 1972)

microorganism starting material from nature." Argoudelis at 1392, 168 USPQ at 101-102. As explained:

[A] unique aspect of using microorganisms as starting materials is that a sufficient description of how to obtain the microorganism from nature cannot be given. Such a description could only detail an experimental screening program similar to the screening programs followed in discovering the microorganism in the first instance. If the microorganism involved were of very common occurrence, it might be found in a relatively short time, but if it were not of common occurrence, it might not be found for a very long time, if found at all. The microorganism involved here, of course, was not known and available to the workers in the art since it was newly discovered by appellants.

Argoudelis at 1392, 168 USPQ at 102.

Given those circumstances where an applicant for a utility patent could not describe by way of words how to make a needed biological material, the CCPA determined that the applicant could deposit the needed biological material in a public depository under conditions assuring access by the public to the biological material upon issuance of a patent. Thus, such utility patents are considered enabled, not by the fact that the public can make or recreate the needed biological material, but by the fact that the public is given possession of the needed biological material upon issuance of the patent. Since the time of Argoudelis, the procedures for the deposit of biological material in order to comply with the enablement requirement under 35 U.S.C. § 112, first paragraph, have been the subject of rule making by the USPTO and are now codified in 37 CFR §§ 1.801 - 1.809. 37 CFR § 1.802(b) reads:

Biological material need not be deposited unless access to such material is necessary for the satisfaction of the statutory requirements for patentability under 35 U.S.C. 112. If a deposit is necessary, it shall be acceptable if made in accordance with these regulations. Biological material need not be deposited, inter alia, if it is known and readily available to the public or can be made or isolated without undue experimentation. Once deposited in a depository complying with these regulations, a biological material will be considered to be readily available even though some requirement of law or regulation of the United States or

of the country in which the depository institution is located permits access to the material only under conditions imposed for safety, public health or similar reasons.

As seen, an applicant need not deposit needed biological material if that material is publically available or can be made or isolated. The deposit rules equate existing public availability of needed biological material, the ability of the public to make, recreate or re-isolate the material and deposit of the material with access to public upon issuance of a patent. Any of these three circumstances will satisfy the enablement requirement. It makes little sense to say that a utility patent is enabled by way of the public being able to physically possess needed biological material where written words do not suffice to instruct one of ordinary skill in the art how to make or recreate the material, yet say that a printed publication describing the existence of a plant is nonenabled even though the public can in similar manner "possess" the plant due to its public availability.

The public availability of Pendec in countries other than the United States does not negate its effect in enabling the printed publication relied upon by the examiner. A similar issue was considered in In re Metcalfe, 410 F.2d 1378, 161 USPQ 789 (CCPA 1969) in the context of whether claims pending in a utility application were enabled. One of the issues resolved in Metcalfe was whether pamphlets from Australian companies could be relied upon as evidence that the pending claims were enabled when it was not clear the pamphlets were available in the United States. The court stated "we are unaware of any authority holding that published material of the type under consideration must be from the United States. Section 112 simply requires that a disclosure of an invention enable any man skilled in the relevant art to make and use it. No mention of convenience is made; thus, even if the origin of the material is in

Australia, this is merely a matter of degree of convenience and not a matter of lack of availability." Metcalfe, at 1381, 161 USPQ at 791.

We think this principle applies equally to the present situation in considering whether the printed publication relied upon by the examiner is enabled. The public availability of Pendec in countries other than the United States is a matter of convenience, not access. The printed publication clause of § 102(b) is not limited to publications "in this country" as are the "on sale" and "public use" clauses. Since the printed publication clause of § 102(b) is not limited by location, we see no reason to geographically limit the evidence available to be used in determining whether a printed publication is enabled. In our view, description of a claimed plant in a printed publication more than one year prior to the filing date for a plant application patent in this country, coupled with the public availability of the plant in countries other than the United States creates a statutory bar to obtaining a plant patent on the plant.⁵

Appellant argues that asserting a PBR publication is enabling prior art alone or in combination with the sale or use outside the United States is inconsistent with the examination practice of requiring detailed botanical information in plant patent applications. Appeal Brief, page 18. It is not clear what point appellant is making here. Whether a specification of a plant patent application contains sufficient information to describe the plant in issue is separate and distinct from whether a prior art reference is

⁵ While not relied upon by appellant, we have reviewed In re Foster, 343 F.2d 980, 145 USPQ 166 (CCPA 1966), cert. denied, 383 U.S. 966 (1966) since the case also discusses the requirements of 35 U.S.C. § 102(b), albeit in a different context. In Foster, the court observed:

"[S]ince the purpose of [§ 102(b)] has always been to require filing of the application within the prescribed period after the public came into possession of the invention, we cannot see that it makes any difference how [it] came into such possession, whether by a public use, a sale, a single patent or publication, or by combination of one or more of the foregoing."

Foster, at 988, 145 USPQ at 173. In making this observation the court did not limit "public use" and "a sale" to those which occur in this country. While it is not clear from the opinion whether the court meant for those terms to be unlimited by geography, it is clear that a combination of events may be used to establish a § 102(b) bar.

enabling. The amount of description a specification need contain in a plant patent application in order to comply with the requirements of 35 U.S.C. § 162 is not before us for review in this appeal.

Appellant argues that the rejection in this case places the "foreign plant patent breeder at a distinct economic disadvantage." Appeal Brief, pages 19-20. In considering this argument, we note our decision does not foreclose or prevent access to the United States patent system by a plant breeder, regardless of whether the breeder conducts his business in this country or in a country other than the United States. What our decision means is that plant breeders must file their plant patent applications in the United States in a more timely manner than apparently has been the practice. We find no legal impediment to plant breeders, including the present appellant, filing their plant patent applications in the United States within a year of describing their plant in a printed publication and providing access to the public to the plant overseas.

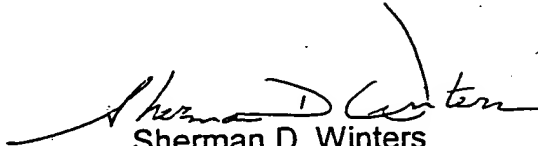
Appellant appears to be of the mind that plant breeders should be free to pursue legal protection of a plant in the countries other than the United States and in so doing provide public notice of the existence of a plant concurrent with making the plant available to the public in countries other than the United States by way of commercial sales or other avenues, yet be able to delay seeking patent protection in this country until they decide whether the plant is commercially important in this country. We have no doubt that many industries and inventors would find that set of circumstances desirable. However this is not what the patent statutes provide for in this country. The CCPA stated in LeGrice that the plant patent statutes, 35 U.S.C. §§ 161-164, provide a single exception to the other statutory requirements for granting of a patent. LeGrice at 933, 133 USPQ at 369 ("35 U.S.C. § 161 engrafts the Plant Patent Act onto the basic


patent law, which requires us to apply thereto all the rules, regulations and provisions of the basic patent law except that, by the express provision of 35 U.S.C. 162, a plant patent cannot be declared invalid if its description 'is as complete as is reasonably possible'"). We do not find it appropriate to create another exception for appellant.


Nor do we find the argued cost burden to be unique to plant breeders. There are no doubt many industries and inventors faced with difficult decisions as to which inventions to seek patent protection. Such decisions are based in large part on, if not governed by, economic circumstances. It must be remembered that it was appellant's own actions which resulted in the printed publication that forms the basis for the present rejection and appellant's own actions which placed the claimed plant on sale overseas or otherwise made the plant publicly available in the relevant time frame. If appellant wanted the luxury of delaying his decision as to which plants should be protected by plant patents in the United States, appellant should have developed the present plant to the point of deciding whether it is commercially viable in this country without generating statutory bars under 35 U.S.C. § 102(b).

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED


Sherman D. Winters
Administrative Patent Judge


William F. Smith
Administrative Patent Judge


Donald E. Adams
Administrative Patent Judge

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Appeal No. 2003-0841
Application No. 09/664,247

Page 17

Russell D. Orkin
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

ELD

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that the accompanying paper was filed.

Applicant(s) Wilhelm Elsner
Title "Variety of Geranium Named 'PENDEC'"
Pgs. of Spec. 7 Claims 1p Abstract 1 p.
Sheets of Dwgs. 2 Declaration 2pp.
Small Entity Statement Yes ☐ No ☒
Application Transmittal Letter(is trip.) X
Recordation Form Cover Sheet - Patents Only X
Assignment 1p
Amount of Check(s) \$480/\$40
Express Mail No. EL561512948US
Atty's File No. 2384/001440
Initials RDO/GFM/bak

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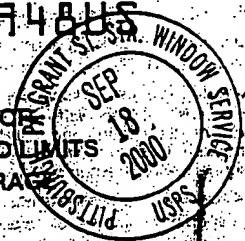
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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

ATTORNEY'S DOCKET NUMBER

Wilhelm Elsner

2384/001440

ENTITLED

"Variety of Geranium Named 'PENDEC'"

To the Application Branch

Assistant Commissioner for Patents
Washington, D.C. 20231

EXPRESS MAIL CERTIFICATE

"Express Mail" Label Number EL561512948US

Date of Deposit September 18, 2000

I hereby certify that the following attached paper or fee
PATENT APPLICATION TRANSMITTAL LETTER (original and two (2)
copies); Plant Patent Application (7pp.); 2 original drawings;
~~_____~~; Declaration and Power of
Attorney (2pp.); Assignment (1p.); Assignment Transmittal -
Patents Only - (1p.) and check in amount of \$480.00; and a check
in the amount of \$40.00

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Beth Kennedy

(Typed name of person mailing paper or fee)

Beth Kennedy
(Signature of person mailing paper or fee)

PATENT APPLICATION TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Transmitted herewith for filing is the patent application of: Wilhelm Elsner

Entitled: Variety of Geranium Named 'PENDEC'

Enclosed are: X 2 sheets of drawings

X An Assignment of the invention to: Elsner pac Jungpflanzen

X Declaration

 Small Entity Statement under 37 CFR 1.9 and 1.27

CLAIMS AS FILED

<u>No. Filed</u>	<u>No. Extra</u>	<u>Small Entity Rate</u>	<u>Non-Small Entity Rate</u>	<u>Charge</u>
Total				
Claims <u>1</u> -20 = <u>0</u>		x \$ 9.00	x \$ 18.00	\$ <u>0</u>
Indep.				
Claims <u>0</u> -3 = <u>0</u>		x \$ 39.00	x \$ 78.00	\$ <u>0</u>
Multiple Dependent Claim/s		+ \$130.00	+ \$260.00	\$ <u>0</u>
Basic Fee		+ \$345.00	+ \$690.00	\$ <u>480.00</u>
		Total of above Charges		\$ <u>0</u>
		Total Fee		\$ <u>480.00</u>

A check/s in the amount/s of \$ 480.00/40.00 is enclosed to cover the filing fee and Assignment recordal.

The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR 1.16 or patent application processing fees under 37 CFR 1.17 associated with this communication to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650.

An original and two copies of this sheet are enclosed.

September 18, 2000
Date

By Russell D. Orkin
Russell D. Orkin
Attorney for Applicant
Registration No. 25,363
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818
Telephone: 412-471-8815
Facsimile: 412-471-4094

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PATENT APPLICATION
Attorney Docket No. 2384-001440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Wilhelm ELSNER

Serial No. Not Yet Assigned

Filed Concurrently Herewith

VARIETY OF GERANIUM
NAMED 'PENDEC'

Pittsburgh, Pennsylvania
September 18, 2000

LETTER RECOGNIZING ATTORNEYS

BOX PLANT PATENT APPLICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed for filing is an informal application for a plant patent application
as above identified, comprising a specification, claim, and one (4) sheets of drawings.

Information regarding the inventor and the application is as follows:

1. Name and Residence Address,
First Inventor:

Wilhelm ELSNER
Weesensteiner Strasse 14
D-01279 Dresden, GERMANY

Citizenship:

German

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Beth Kennedy
(Type or Print Name of Person Mailing Paper)

Beth Kennedy
25

2. Title: VARIETY OF GERANIUM
NAMED 'PENDEC'
3. Drawings: One (4) Mounted Photographs
4. Claims: One (1) claim

Please accept the application for purposes of granting a filing date and recognize Russell D. Orkin, Registration No. 25,363; Julie W. Meder, Registration No. 36,216; and Gary F. Matz, Registration No. 45,504 as attorneys in this application, pending the filing of a formal Declaration and Power of Attorney and payment of the filing fee. 37 C.F.R. § 1.53(b).

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By



Russell D. Orkin
Registration No. 25,363
Attorney for Applicant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219
Telephone No.: 412-471-8815
Facsimile No.: 412-471-4094

VARIETY OF GERANIUM NAMED 'PENDEC'

BACKGROUND OF THE INVENTION

This discovery relates to a new and distinct cultivar of *Pelargonium x peltatum* known by the varietal name of 'Pendec.' The seedling from the present variety is a spontaneous mutation of 'Pendresd' (patent pending). The new variety was discovered in France on June 22, 1996. The new variety was first asexually reproduced by cuttings at Elsner pac Jungpflanzen in Dresden, Germany on October 15, 1996. It has been found to retain its distinctive characteristics through successive propagations.

10 The new cultivar has similar flower color and form to 'Pendresd' but is a shorter internode length and has yellower stems than 'Pendresd.'

 The cultivar, when grown in a glass greenhouse at high humidity using natural light and 18°C night and 20°C day, has a response time of ten weeks from a rooted cutting to flowering in a 10 cm pot. The response time was
15 determined on plants grown in peat substrates.

DESCRIPTION OF THE DRAWING

 The accompanying photographic drawing illustrates the new variety, with the color being as nearly true as is possible with color illustrations of this type.

20 DESCRIPTION OF THE PLANT

 The following detailed descriptions set forth the characteristics of the new variety. The data which define these characteristics were collected from asexual reproductions carried out at Elsner pac Jungpflanzen, Kipsdorfer Strasse 146, D-01279, Dresden, Germany. The color readings were taken in
25 natural light. Color references are primarily to the Royal Horticultural Society Colour Chart.

THE PLANT

Classification:

 Botanical: *Pelargonium x pelatatum*.
30 Varietal: Ivy-geranium named 'Pendec'.

Commercial: Ivy-geranium named 'Ville de Dresden, Deror'.

Form: Cascading mound.

Height: Up to 70 - 80 cm.

Growth: Hanging, very high degree of branching.

5 Strength: No artificial support required.

Foliage: Alternate leaf attachment.

Rooting time: 3.5 - 4 weeks.

Leaves:

Size:

10 Length: 5.5 cm.

Width: 4 - 5 cm.

Shape: Ivy-shaped.

Margin: Pedately lobed with serrations.

Color:

15 Top surface: Green Group 137A.

Bottom surface: Green Group 138A.

Zone: Green Group 139A.

Ribs and veins:

Venation: Palmate.

20 Color: Green Group 144A on lower surface.

Petioles:

Length: Up to 2 cm.

Color: Yellow-green Group 145C.

Stem:

25 Color: Yellow Group 150C.

Internode length: 2 - 4 cm.

THE BUD

Cluster:

Shape: Nearly in one line.

Size: Approximately 2.5 cm diameter.

Number of buds per cluster: Approximately seven.

Individual buds (when showing five leaf pairs):

Shape: Elongated.

5 Size: 3 mm wide, up to 1 cm long.

INFLORESCENCE

Blooming habit: Windmill-shaped.

Borne: Umbel, florets on pedicel, pedicel on peduncle.

Size of umbel: 7 - 9 cm in diameter.

10 Open florets:

Form: Single, free spaces between petals, approximately seven florets per umbel.

Size: 3 cm wide, 4.5 cm high, 2 cm deep.

Petals:

15 Color:

Top surface: Red Group 56D

Bottom surface: White Group 155D.

Shape: Spoon-shaped.

Size:

20 Upper: 1.5 cm wide, 2.7 cm long.

Lower: 1.1 cm wide, 2.2 cm long.

Texture and appearance: Smooth.

Tonality from a distance: White pearls over green foliage.

Petaloids: None.

25 Pedicel:

Length: 2.5 - 3 cm.

Color: Yellow Group 145C and Red Group 60B.

Peduncle:

Length: 4 - 6 cm.

Color: Yellow-green Group 145C.

Disease and pest resistance: No unusual susceptibility and to disease or pests
seen to date.

Lasting quality: Flowers hold 8 - 10 days, depending on weather conditions;
5 resistant in rain.

REPRODUCTIVE ORGANS

Stamens:

Anthers: Up to 3 mm long.

Filaments:

10 Length: Up to 5 mm.

Color: Yellow Group 11D.

Pollen: Bright yellow.

Pistils:

Number: 1;5 parted.

15 Length: 1 - 1.2 cm.

Stigma:

Number: 1;5 parted.

Color: Red-purple Group 59D.

Style:

20 Color: White.

Length: 5 mm.

Ovaries:

Color: Green Group 141C.

Size: 5 mm long; 2 mm wide.

25 Pubescence: Some present.

Fruit: None observed.

GENERAL CHARACTERISTICS

The new geranium variety provides a flower color similar to its
parent, 'Pendresd,' with a shorter internode length and a different color stem

(yellow) using minimal fertilization. It is rich flowering, well-branched, hangs well, and has a stable flower color under intense sunlight. These properties provide an impressive appearance from a distance. Cutting production and wind resistance are excellent.

I CLAIM:

1. A new and distinct variety of geranium plant named 'Pendec'
as described and illustrated herein.

ABSTRACT

A new and distinct variety of geranium having flowers with a pinkish-white color above medium green foliage and a yellow stem. It provides superb cuttings and performs well in a hanging basket. The blooms hold up well
5 when exposed to direct sunlight.



DECLARATION AND POWER OF ATTORNEY

I, WILHELM ELSNER, declare:

I am a citizen of Germany whose post-office address is Weesensteiner Strasse 14, D-01279 Dresden, Germany.

I believe myself to be the original, first and sole inventor of the improvement entitled VARIETY OF GERANIUM NAMED 'PENDEC' which is described and claimed in the annexed specification.

I have asexually reproduced the new and distinct variety.

I have received and understand the contents of the specification, including the claim.

I do not know and do not believe that the same was ever known or used in the United States before our invention thereof; or patented or described in any printed publication in any country before my invention or more than one year prior to this application; or in public use or on sale in the United States more than one year prior to this application.

Said invention has not been patented or been made the subject of an inventor's certificate in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months prior to this application.

I acknowledge my duty to disclose information of which I am aware which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

No application for patent or inventor's certificate thereon has been filed by me or my legal representatives or assigns in any country foreign to the United States.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

I hereby appoint Russell D. Orkin, Registration No. 25,363; William H. Logsdon, Registration No. 22,132; David C. Hanson, Registration No. 23,024; Richard L. Byrne, Registration No. 28,498; Frederick B. Ziesenheim, Registration No. 19,438; Kent E. Baldauf, Registration No. 25,826; Barbara E. Johnson, Registration No. 31,198; Paul M. Reznick, Registration No. 33,059; John W. McIlvaine, Registration No. 34,219; Michael I. Shamos, Registration No. 30,424; Blynn L. Shideler, Registration No. 35,034; Julie W. Meder, Registration No. 36,216; Lester N. Fortney, Registration No. 38,141; Jesse A. Hirshman, Registration No. 40,016; Randall A. Notzen, Registration No. 36,882; James G. Porcelli, Registration No. 33,757; Kent E. Baldauf, Jr., Registration No. 36,082; Christian E. Schuster, Registration No. 43,908; Deborah M. Altman, Registration No. 42,259; Dean E. Geibel.

Registration No. 42,570; Thomas J. Clinton, Registration No. 40,561; and Nathan J. Prepelka, Registration No. 43,016, whose post-office address is 700 Koppers Building, 436 Seventh Avenue, Pittsburgh, Pennsylvania 15219-1818, Telephone No. 412-471-8815, my attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, to amend the specification, to appeal in case of rejection, as they may deem advisable, to receive the patent when granted and generally to do all matters and things needful in the premises, as fully and to all intents and purposes as we could do.

All correspondence and telephone calls should be addressed to Russell D. Orkin.

I hereby subscribe my name to the foregoing specification and claims, declaration and power of attorney.

Date 08.09.00

Inventor Wilhelm Elsner
Wilhelm Elsner

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1. Name of conveying party(ies):
Wilhelm Elsner

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name☐ Other _____Execution Date: September 8, 2000

2. Name and address of receiving party(ies)

Name: Elsner pac Jungpflanzen

Internal Address: _____

Street Address: Kipsdorfer Strasse 146City: D-01279 Dresden, Germany

State: _____ ZIP: _____

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application,
the execution date of the application is: September 8, 2000

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Russell D. OrkinInternal Address: Webb Ziesenheim LogsdonOrkin & Hanson, P.C.Street Address: 700 Koppers Building436 Seventh AvenueCity: Pittsburgh State: PA ZIP: 15219-18186. Total number of applications and patents involved: 17. Total fee (37 CFR 3.41).....\$ 40.00☒ Enclosed☐ Authorized to be charged to deposit account

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9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Russell D. Orkin

Name of Person Signing

Reg. No. 25,363

Russell D. Orkin
SignatureSeptember 18, 2000
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ASSIGNMENT

WHEREAS, I, WILHELM ELSNER, residing in Dresden, Germany, have invented certain new and useful improvements in VARIETY OF GERANIUM NAMED 'PENDEC' for which a patent application is being filed concurrently herewith;

AND, WHEREAS Elsner Pac Jungpflanzen, a corporation of Germany, having a place of business at Kipsdorfer Straße 146, D-01279 Dresden, Germany, hereinafter called the "assignee", is desirous of acquiring the entire right, title, and interest in and to said application and the inventions and improvements therein disclosed.

NOW, THEREFORE, for good and valuable consideration paid to me by said assignee, the receipt of which is hereby acknowledged, I do hereby assign, sell, transfer, and set over unto said assignee the entire right, title and interest in and to said application and the inventions and improvements therein disclosed for the United States and all foreign countries and any Letters Patent which may issue therefor in the United States and all foreign countries and all divisions, reissues, continuations, continuations-in-part, renewals, and/or extensions thereof, said assignee to have and to hold the interests herein assigned to the full ends of the terms of said Letters Patent and any and all divisions, reissues, continuations, continuations-in-part, renewals, and/or extensions thereof, respectively, as fully and entirely as the same would have been held and enjoyed by me had this assignment not been made.

I authorize and request my attorney to insert above the application number when it becomes known;

The Assistant Commissioner for Patents is requested to issue such Letters Patent in accordance herewith. I covenant that I am the lawful owner of the said application, inventions, and improvements, that the same are unencumbered, that no license has been granted to make, use, or vend the said inventions or improvements or any of them, and that I have the full right to make this assignment.

And for the consideration aforesaid, I agree solely and individually that I will communicate to said assignee or the representatives thereof any facts known to me respecting said inventions and improvements, and will, upon request, but without expense to me, testify in any legal proceedings, sign all lawful papers, execute all divisional, reissue, continuation, continuation-in-part, renewal, and/or extension applications, make all rightful oaths, and generally do all other and further lawful acts, deemed necessary or expedient by said assignee or by counsel for said assignee, to assist or enable said assignee to obtain and enforce full benefits from the rights and interests herein assigned. This assignment shall be binding upon my heirs, executors, administrators, and/or assigns, and shall inure to the benefit of the heirs, executors, administrators, successors, and/or assigns, as the case may be, of said assignee.

08.09.00.

Date

Wilhelm Elsner

Wilhelm Elsner

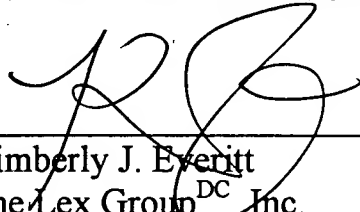
CERTIFICATE OF FILING AND SERVICE

I hereby certify that on October 20, 2003, two (2) true and correct copies of the foregoing Brief of Appellant were served by United States First Class Mail, postage prepaid, on counsel as noted below. Also on this date the original and eleven (11) copies of the Brief were provided to the Court by hand delivery.

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Filing and service were performed under instruction of Counsel.



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